Remarks

Claims 27-48 are pending. Claims 1-26 are canceled and new Claims 35-48 are added in this Response.

Allowable Subject Matter

Claims 28 and 32 were objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form. For the reasons noted below, Applicant feels the base claims should be allowed. Applicant, therefore, has elected not to rewrite Claims 28 and 32 at this time.

New Claims 37-40

New Claims 37 and 39 are similar to Claims 28 and 32, respectively, without the fail safe rule limitations. New Claim 41 is an apparatus counterpart to Claim 27 but not limited to print data. New Claim 46 is an apparatus counterpart to Claim 37 but not limited to print data.

Rejections Under 35 U.S.C. § 101

The preamble to Claim 27 has been amended as suggested by the Examiner. Applicant requests, therefore, withdrawal of the Section 101 rejection.

Rejections Based On Mercer

Claims 27, 30, 31 and 34 were rejected under Section 102(e) as being anticipated by Mercer (6547830). Claims 29 and 33 were rejected under Section 103 as being obvious over Mercer. The rejections are based on the assertion that a web browser in Mercer "inherently comprises a 'fail safe rule'...." as claimed. In support of the rejection, the Examiner states:

> The browser *inherently* comprises a "*fail safe rule*" in that either the methods will fully execute with no problem and the browser will display the web page, or, upon encountering any problem during execution of the methods that will not permit display of the web page, the browser displays an error message. Accordingly, either the rules will execute and the web page is displayed, or the rules will not execute and an error message is displayed. Whenever the rules execute and the web page is displayed, the "*fail safe rule*" is "applied to the print data" and "*conforms the print data to the higher level rule.*" Office Action, page 13 (emphasis in original).

As detailed below, the Examiner's inherency argument fails for two reasons. First, it fails the test for inherency. Second, it is factually inaccurate.

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Claim 27 recites establishing (1) a higher level rule, (2) lower level rules configured to change print data to conform to the higher level rule, and (3) a fail safe rule that when applied conforms the print data to the higher level rule. The fail safe rule is applied if applying the lower level rules does not confirm the print data to the higher level rule. Claim 31 is a computer medium counterpart to Claim 27 and contains similar limitations.

Test For Inherency Not Met. To establish inherency, the Examiner must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. MPEP § 2112, paragraph IV.

The Examiner asserts maximizing the text displayed in Mercer is the claimed higher level rule and that Mercer's distance reduction and font reduction and substitution methods are the claimed lower level rules. Even assuming these assertions are correct, there is still no fail safe rule in Mercer. Indeed, a fail safe rule in Mercer is unnecessary due to the nature of his so-called higher level rule. Implementing the so-called lower level rules will always conform the display data to the higher level rule in Mercer -- implementing the lower level rules, by definition, maximizes the text that is displayed. Hence, there is no need for a further rule, a fail safe rule, to apply in the event the lower level rules fail to conform the data to the higher level rule because the lower level rules will always conform the data to the higher level rule. The Examiner has failed to show the fail safe rule limitations of Claims 27 and 31 are inherent in Mercer. In fact, the fail safe rule limitations are not inherent in Mercer.

Examiner's Argument Is Factually Not Accurate. The Examiner asserts that Mercer teaches "upon encountering any problem during execution of the methods that will not permit display of the web page, the browser displays an error message." This assertion is not correct. There is no such teaching in Mercer. Mercer does not even suggest the possibility that the methods (the lower level rules) might somehow fail to execute fully. Indeed, the notion of Mercer's lower level rules "fully" executing

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is a misnomer. As noted above, due to the nature of Mercer's higher level rule, executing the lower level rules to whatever extent is possible in any particular circumstance will maximize the text that is displayed and thereby conform the display data to the higher level rule. If the Examiner disagrees, he is respectfully requested to specifically point out and explain the language in Mercer that supports his position.

Rejections Based On Kojima

Claims 27, 30, 31 and 34 were rejected under Section 102(e) as being anticipated by Kojima (6633401). Claims 29 and 33 were rejected under Section 103 as being obvious over Kojima. The rejections are based on the assertion that Kojima's default formatting rules are the claimed fail safe rule. This assertion is not correct.

Claim 27 recites establishing (1) a higher level rule, (2) lower level rules configured to change print data to conform to the higher level rule, and (3) a fail safe rule that when applied conforms the print data to the higher level rule. The fail safe rule is applied if applying the lower level rules does not confirm the print data to the higher level rule. Claim 31 is a computer medium counterpart to Claim 27 and contains similar limitations.

Kojima teaches applying a designated format to the print data or applying a default format to the print data, but not both. Kojima column 9, line 51-53 ("The intermediate data is generated based on any one of the default e-mail format 211a, the designated mail format 211b....") As the Examiner correctly notes, Kojima teaches using the default format in the absence of a designated format. Kojima, however, does not teach any circumstances under which both a designated format and a default format are applied to the same print data. Hence, Kojima does not teach applying one rule (a fail safe rule) to the print data if applying a different rule (the lower level rules) does not conform the print data to a higher level rule.

Again, if the Examiner disagrees, he is respectfully requested to specifically point out and explain the language in Kojima that teaches or even suggests applying a second rule (the default rule) that conforms the print data to a higher level rule if applying a first rule (the designated rule) to the print data does not conform the print

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data to the higher level rule. Absent such a showing, the rejections based on Kojima should be withdrawn.

The foregoing is believed to be a complete response to the outstanding office action.

Respectfully submitted,

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